



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,895	11/19/2001	Jonathan J. Hull	015358-006500US	1059

20350 7590 07/08/2004

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

BAUTISTA, XIOMARA L

ART UNIT	PAPER NUMBER
----------	--------------

2173

DATE MAILED: 07/08/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/001,895

Applicant(s)

HULL ET AL.

Examiner

X L Bautista

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7 & 8.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2173

## DETAILED ACTION

### *Specification*

1. The attempt to incorporate subject matter into this application by reference to "No. \_\_/\_\_.\_\_" is improper because a serial number and filing date is needed for each application incorporated by reference.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 31-36 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 31-36 recite a paper document. These claims do not truly fit any of the four statutory classes of invention, "process, machine, manufacture, or composition matter." They are not even held upon a computer-readable medium, as discussed in the Guidelines for examination, 1995. The claims recite nothing more than information, having some potential use to a computer capable of reading and interpreting them, in a manner analogous to the information content of printed matter, long held to be non-statutory.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-7, 9, 11-16, 18, 19, 21-23, 25, 26, 30, 31, 33-35, 37-43, 45, 47-52, 54, 55, 57-59, 61, 62, 66-69, 71-75, and 78 are rejected under 35 U.S.C. 102(e) as being anticipated by *Schilling et al* (US 5,706,097).**

Claims 1, 11, 37, 47, 67, and 72:

Schelling teaches a method of generating an index print (printable representation) for a multimedia document having multimedia information of a first type and a second type (text, audio, video), (abstract; col. 1, lines 58-

Art Unit: 2173

67; col. 2, lines 1-20). The method has layout information for printing the printable representation of the first and second type on a paper medium (col. 3, lines 1-40).

Claims 2, 38, and 68:

See claim 1. Schilling teaches users can select the text, graphics, frames, or sound sequences to be included in the index print. Schilling teaches that textual information is generated relating the file such as file size or duration of the sequence (col. 3, lines 1-40).

Claims 3 and 39:

See claim 2. Schilling teaches type indicator icons for indicating that the file contains a still image, sound sequence, video frames, text, etc., which enables the user to easily select the file he is interested in (col. 2, lines 43-67).

Claims 4 and 40:

See claim 3. Schilling teaches index codes such as sequence numbers, track numbers, title, etc. (col. 3, lines 1-40; col. 4, lines 58-67; col. 5, lines 1-5).

Claims 5, 6, 41, and 42:

See claim 3. Schilling teaches that users can select desired objects (first and second type), create a printable representation for a set of pages,

Art Unit: 2173

and print them on a page or pages (col. 3, lines 1-40, 53-67; col. 4, lines 1-7).

Claims 7, 34, 43, and 69:

See claim 1. Schelling teaches information such as video (keyframes) information (abstract; col. 1, lines 58-67; col. 2, lines 1-20; col. 3, lines 1-40).

Claims 9, 18, 30, 33, 45, 54, 66, 71, and 78:

See claim 1. Schelling teaches an indicator icon that indicates files containing sound and a text message describing the data file. Shelling illustrates text relating to (fig. 1) a sound recording (audio information) of a person's (i.e. Grandma's) voice (col. 2, lines 62-67; col. 3, lines 10-29).

Claims 12-16, 19, 21, 22, 48-52, 55, 57, 58, 73, and 74:

See claim 1. Schelling teaches that information such as file size or duration of a sequence, date and time or recording of data, etc. may be added to the subject matter descriptor (col. 3, lines 7-25; col. 4, lines 9-21; fig. 5). Schelling teaches user-selectable identifier on the index print for each image printed on the index, wherein the identifier enables user access to multimedia information (col. 2, lines 54-67; col. 4, lines 57-67; col. 5, lines 13-14).

Art Unit: 2173

Claims 23, 25, 35, 59, 61, and 75:

See claim 12. Schelling teaches still image information and other information such as file size or duration of a sequence, date and time or recording of the data, etc. (col. 3, lines 7-25; col. 4, lines 9-21).

Claims 26 and 62:

See claims 3 and 9. Schelling teaches type indicators (identifiers) printed proximal to an image and/or text information (fig. 1).

Claim 31:

See claim 12. Schelling discloses a method for identifying images and sound recordings (multimedia) on a digital recording medium. The recording medium has individually addressable digital data files containing still images, motion sequences and sound sequences, an index print (coversheet) having a plurality of index images representing the still images, motion sequences and sound sequences on the digital recording medium. Schelling teaches that the index print may be used for printing an image (thumbnail) of the document (page, index print), (abstract; col. 1, lines 58-67; col. 2, lines 1-14, 43-67; col. 4, lines 57-67; col. 5, lines 6-12).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the

basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 8, 17, 20, 27-29, 32, 44, 53, 56, 63-65, 70, and 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling and Gibbon et al* (US 6,098,082).**

Claims 8, 17, 44, 53, and 70:

See claim 7. Schelling does not teach that the multimedia document includes printed closed-caption text information. However, Gibbon discloses a method for providing a compressed rendition of a video program in a format suitable for electronic searching and retrieval on the WWW. Gibbon teaches pictorial transcripts that are compact representations of video programs which are automatically generated by selecting representative frames or images from the video program and combining them with a second media component such as audio or text which is associated with each representative frame (abstract; col. 1, lines 55-67; col. 2, lines 1-15; col. 3, lines 10-15). Gibbon teaches that a printed rendition of closed-captioned text may be provided. The printed rendition is a pictorial transcript in which each representative frame is printed with a caption containing the portion of



Art Unit: 2173

the closed-caption text corresponding to the scene from which the representative frame is taken (col. 3, lines 16-22). Thus, it would have been obvious to a person having ordinary skill in the art at the time of invention to modify Schilling to include Gibbon's teaching of printing closed-caption text because it provides a printable visual presentation of the sound associated with the image (frame) of interest; therefore, close captioning is not only visible on a TV receiver designed to display it but it is also visible when being printed on paper.

Claims 20, 27, 56, 63, and 77:

See claims 8 and 12. Schelling teaches that information such as file size or duration of a sequence, date and time or recording of data, etc. may be added to the subject matter descriptor (col. 3, lines 7-25; col. 4, lines 9-21; fig. 5). Gibbon teaches closed caption text information (col. 3, lines 16-22).

Claims 28, 29, 64, and 65:

See claims 8, 9, and 12. Gibbon teaches a pictorial transcript, which has three sequential images without any intervening captions (fig. 2a; col. 8, lines 15-16).

Claim 32:

See claim 8. Gibbon teaches pictorial transcripts that are compact

Art Unit: 2173

representations of video programs which are automatically generated by selecting representative frames or images from the video program and combining them with a second media component such as audio or text which is associated with each representative frame (abstract; col. 1, lines 55-67; col. 2, lines 1-15; col. 3, lines 10-15). Gibbon teaches that a printed rendition of closed-captioned text may be provided. The printed rendition is a pictorial transcript in which each representative frame is printed with a caption containing the portion of the closed-caption text corresponding to the scene from which the representative frame is taken (col. 3, lines 16-22).

8. **Claims 10 and 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling/Gibbon* and *Geaghan et al* (US 6,098,082).**

Claims 10 and 46:

See claim 8. Schelling/Gibbon teaches a printed index having text, graphic, video, audio information, and closed caption information but does not teach whiteboard information. However, Geaghan discloses an electronic whiteboard with multifunctional user interface that enables users to create, retain and review information (abstract; col. 1, lines 52-67; col. 2, lines 1-13; col. 31, lines 55-62). Geaghan teaches that users can print images and notations from a whiteboard (col. 1, lines 38-49; col. 32, lines 7-

Art Unit: 2173

12). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schelling/Gibbon's system of printing multimedia information to include printable whiteboard information because users are enabled to print any images or notations created by multiple users across a network.

9. **Claims 24, 36, 60, and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Schelling* and *Geaghan*.**

Claims 24, 36, 60, 76:

See claims 10 and 12. Schilling teaches time range and Geaghan teaches printing of whiteboard images and notations (Geaghan: col. 1, lines 38-49; col. 32, lines 7-12).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X L Bautista whose telephone number is (703) 305-3921. The examiner can normally be reached on Monday-Thursday (8:00-18:00), Fridays Off.

Art Unit: 2173

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W Cabeca can be reached on (703) 308-3116. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



X L Bautista  
Patent Examiner  
Art Unit 2173

xlb  
21 June 2004